THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DONALD R. HUENE

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Appeal No. 1997-3989
Application No. 08/424,067[1]

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HEARD: September 14, 1999

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Before PATE, STAAB and CRAWFORD, **Administrative Patent Judges.**

PATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 25 through 32. These are the only claims remaining in the application.

[1] Application for patent filed April 19, 1995. According to appellant, this application is a divisional of application no. 08/203,764, filed March 1, 1994, which is a continuation of application no. 07/875,262, filed April 28, 1992, both now abandoned.

The claimed invention is directed to a driver for absorbable bone screws. These bone screws, being made of a soft polymeric material, are susceptible to "camming out" when a normal screwdriver is used by a surgeon to emplace them in bone. Appellants' driver includes a plurality of driver elements equiangularly disposed about and extending from a tube portion parallel to the driver longitudinal axis. These driver elements, either cylindrical post or rectangular keys, mate with matching depressions in the head of the bone screw, and are not susceptible to camming out.

The claimed invention can be further understood with reference to the appealed claims which are appended to appellant's brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Rich 4,466,314 Aug. 21, 1984

Huene, Donald R., "A Method for a Firm Attachment of a Screw on a Screwdriver", Orthopaedic Review, Vol. VII, No. 1, January 1978.

THE REJECTION

Claims 25 through 32 stand rejected under 35 U.S.C. § 103 as unpatentable over Huene in view of Rich. According to the examiner, Huene discloses a screwdriver for securely locking and driving bone screws. The screwdriver includes a threaded

central rod which threadedly engages a threaded portion central to the head of the bone screw for holding the bone screw onto the driver device. Huene does not disclose a plurality of driver elements disposed around the tube portion of the driver.

Rich teaches a driver for inserting a threaded member such as a screw. Rich teaches that the driver engages a threaded member by way of a central threaded rod. The torque transmitting members are a number of driver elements which are spaced away from the threaded rod in a radial direction. These driver elements are disclosed as reducing the screw fatigue failure by allowing the driver to engage the screw through complementary recesses that mate with these driver elements.

The examiner has therefore concluded that it would have been obvious to one of ordinary skill in the art to modify the driver element of Huene with the driver elements being disposed wholly between the inner and outer walls of the tube as taught by Rich in order to reduce screw failure. (See final rejection, paper no. 6, pages 2 and 3.)

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish the ***prima facie*** obviousness of the claims on

appeal. Therefore, the rejection of the claims on appeal will be reversed. Furthermore, we find it unnecessary to consider appellant's additional evidence of nonobviousness. Our reasons follow.

Appellant has argued that the limitation in the preamble of claim 25, i.e., "a driver for an absorbable bone screw", along with the functional language in subpara-graph d directed to such a screw, gives life and meaning to the claims (See brief at page 6, paragraph 1 and reply brief at page 3.) Contrariwise, the examiner argues on page 3 of the answer, that the claim should be construed as merely acceptable for use on such bone screws and as directed to a driver of general utility. In our view, the preamble language when taken in combination with the functional language of sub- paragraph d does give the preambular use limitation life and meaning and the article claim should be construed as directed to a driver not of general utility, but, for the specific purpose of driving absorbable bone screws. ***See Rowe v. Dror***, 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Having dealt with the construction of the claims, we now turn to the prior art. Our review of the prior art publication to the inventor Huene is complicated by the fact that the figures appearing therein are several generations of reproduction removed from the original. Thus, it is difficult for us to ascertain from the reproduced figures, the exact structure of the distal screw contacting end of the driver. However, as represented to us,

the driver element of this reference does not possess two of the limitations of independent claim 1. The driver element of the reference (1) cannot be said to extend parallel to the longitudinal axis of the driver tool, and (2) each driver element of the reference has been represented to us as not disposed between the inner and outer walls without extending into the opening of the tube portion. Without clear evidence, we must accept these representations from appellant's counsel as to the scope and content of this publication.

We note that both references are directed to the driving of metallic screws. In fact, Rich is directed to the driving of titanium screws and discloses transferring torque to the rotatable fastener by a plurality of pins 40. The insertion ends of pins 42 can be rounded and are inserted into holes 22 to transfer the torque. The opposite ends of the pins 44 are connected to a pin plate 46 which is slidably shiftable on a lift collar 48. Rich's flat bladed-pins 156 are mounted in the same manner. Thus, it is apparent to us that Rich teaches mounting the driver elements slidably on the end of the coaxial open tube rather shifting the entire tube via a nut at the opposite end of the handle. The examiner's proposed combination, i.e., looking to the shape of the screw engaging members in Rich, is clearly based on impermissible hindsight in that the teaching of Rich as to the mounting of the pins is not followed, but only a single feature of Rich has been picked for modifying the basic reference. Such picking and choosing of features from the secondary reference is the hallmark of impermissible hindsight.

Additionally, we merely note that we have accepted appellant's construction of the claimed subject matter as directed to an absorbable bone screwdriver. We further note that the examiner has not cited any prior art dealing with driving such soft polymeric materials. This difference goes toward recognition of the problem, a factor not in evidence in the applied prior art. While hard screws exhibit the "camming out" problem, the examiner has provided no evidence that the prior art recognized and solved the problem with respect to soft, polymeric materials. For these reasons, it is our conclusion that the examiner has not provided a ***prima facie*** case of obviousness with respect to the claimed invention on appeal. The rejection of claims 25 through 32 is reversed.

REVERSED

WILLIAM F. PATE III Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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